

### III. REMARKS

Claims 1, 13-16, 19, 26 and 31 are pending in this application. Claims 1, 13-16, 26 and 31 have been amended. Claims 4-9, 11-12, 17-18, 20-25, 27-30 and 32-35 have been canceled. Claims 2-3, 10, 23, 28 and 33 were previously canceled. Claims 1, 4-9 and 11-15 are rejected under 35 USC §101, as allegedly being directed to non-statutory subject matter. Claims 1, 4-9, 11-22, 24-27, 29-32 and 34-35 are rejected under 35 USC §103(a) as allegedly being unpatentable over Puri, US 6064982 ("Puri") and Barritz et al., US 6938027 ("Barritz") and further in view of Fuerst, US 6189029 ("Fuerst") and Canada et al., US 6767660 ("Canada"). Applicant respectfully traverses the 35 USC §103(a) rejections for the reasons provided below.

Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the claims in a subsequent patent application that claims priority to the instant application.

#### A. REJECTION OF CLAIMS 1, 4-9 and 11-15 UNDER 35 U.S.C. §101

In the Office Action, claims 1, 4-9 and 11-15 are rejected under 35 USC 101 alleging Applicant's invention is directed to non-statutory subject matter. Office Action pp.4-5.

Without conceding the correctness of the Office's interpretation, and to facilitate early allowance of the pending claims, Applicant has amended claim 1 to recite, *inter alia*, "generating a report based on the received entity responses, wherein the report

includes the recommendations." Thus, the claims describe a useful function. Accordingly, Applicant asserts that the bases for the Office's rejection have been obviated and respectfully request withdrawal of the rejection.

B. REJECTION OF CLAIMS 1, 4-9, 11-22, 24-27, 29-32 and 34-35 UNDER 35 U.S.C. §103(a)

With regard to the 35 U.S.C. §103(a) rejections of claims 1, 4-9, 11-22, 24-27, 29-32 and 34-35 over Puri and Barritz and further in view of Fuerst and Canada, Applicant asserts that the combined references cited by the Office fail to teach or suggest each and every feature of the claimed invention.

Applicant has amended independent claims 1, 16, 26 and 31. Independent claim 7 has been canceled. Independent claim 13 is now amended as depending from independent claim 1. Dependent claims 14 and 15 now depend from independent claim 1. The amendments to claims 1, 16, 26 and 31 partially combine the subject matter of canceled dependent claims with their respective independent claims. Subject matter for other amendments related to tabulating or tabulation system find support in the specification at p.16; analyzing by comparing baseline response with predetermined value at p.16; reviewing and review system at p.16; recommending and recommendation system at p.17 and displaying and output system at pp. 15 and 17.

The Office alleges the combined references of Puri, Barritz, Fuerst and Canada teach or suggest each and every feature of claims 1, 4-9, 11-22, 24-27, 29-32 and 34-35. Applicant respectfully traverses this assertion. In addition, the combined

references fail to teach or suggest each and every feature of Applicant's claims as amended.

The Office's cited reference to Puri recites a "tool" that "recommends a system configuration that most nearly meets a customer's needs, based upon the results of an interactive customer product selection session in which the customer progresses through a dialog that is implemented in a series of cascading style sheets." C.1 I.47-52. There is no indication that Puri teaches or suggests the evaluation of currently deployed applications. Puri recommends products to create a specific system configuration. By example, a "page is presented automatically after the customers (sic) needs have been assessed and provides a list of products that most nearly fill the customer's needs." There is no teaching or suggestion of evaluating existing applications or recommending that any existing applications be removed.

Similarly, Barritz does not teach or suggest the features of Applicant's invention. The Office's cited references to Barritz recite a general statement about a "number of products" that "survey the files on storage devices at an installation identify the computer products to which they belong, and report what products are installed on the system in terms that users can understand." C.2 I.47-55. In describing the Barritz invention, Barritz recites the "present invention ... monitor[s] the usage of computer programs which includes automatically determining and recording each instance of actual usage of particular software products, as well as the identity of each user of these products." C.6 I.20-25. Barritz does not evaluate the application programs and determine whether to recommend removal of the programs based upon weighted responses to questions tailored to the application needs of the banking entity. Rather,

Barritz clearly restricts examination to the usage of software products. Thus, Barritz does not teach or suggest each and every feature of Applicant's claim 1, as amended.

The Office cites Fuerst in support of its allegations. The cited reference in Fuerst is to Figure 8 and related descriptions. The subject matter of Fuerst is "a software tool that permits creation of electronic surveys and automatic collection and tabulation of survey results corresponding to user responses." Abstract. Figure 8 illustrates a "question input display screen" for creating questions with different types of answers from a drop down menu. Figure 8 and C.6 I.48-60. Fuerst does not teach or suggest formulating questions based on business and information technology strategy, weighting possible responses to the set of questions, assigning values to different responses, tabulating responses to obtain a baseline response, or comparing the baseline response with a predetermined value – all features of Applicant's invention.

Finally, the Office cites Canada in support of its allegations referencing Figure 3D and related description. Figures 3-5, according to Canada, illustrate "information inquiries are used to describe core characteristics." However, the figures "do not provide answers to the core characteristics." C.4 I.55-63. Clearly Canada does not cure the deficiencies of Puri, Barritz and Fuerst.

Applicant submits that the combined references cited by the Office fail to teach or suggest each and every feature of claim 1 (and similarly claims 16, 26 and 31), as amended. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

With respect to the dependent claims, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the

claims depend. Furthermore, Applicant submits that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicant respectfully requests withdrawal of this rejection.

#### **IV. CONCLUSION**

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

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